

REMARKS

Claims 1-12 are pending in this application. New claims 16 and 17 are submitted for consideration. Claim 14 has been canceled. Applicants request that claims 1-12, as well as new claims 16 and 17, which are believed be in condition for allowance, be reexamined or examined in light of the amendments made herein.

With respect to the Information Disclosure Statement (“IDS”) filed on March 24, 2005, Applicants cannot explain the absence of the supporting document except to say that the document, entitled “*Agrobacterium tumefaciens*-mediated transformation of leek (*Allium porrum*) and garlic (*Allium sativum*)”, was provided to the Patent and Trademark Office (“PTO”) on March 24, 2005, in accordance with 37 C.F.R. 1.98(a)(2), with the remainder of the Amendment After Final. A stamped acknowledgment receipt was returned to us by the PTO to verify this point. Nevertheless, Applicants herein submit an additional copy of this reference for the Office’s consideration.

35 U.S.C. § 112, Second Paragraph

Claim 7 stands rejected by the Office, in its Action mailed May 18, 2005, under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter regarded as the invention. *See* Office Action, 05/18/05, p. 3.

Specifically, the Office states that “steps (d), (e) and (f), are confusing because step (f) recites ‘regenerating plants’ without indicating which of the previous steps provides the plant material for ‘regenerating’. Step (d) provides secondary embryos and (e) provides transgenic cultures.” *Id.* at 3. Applicants have amended claim 7 accordingly, and respectfully request that this rejection be withdrawn.

35 U.S.C. § 112, First Paragraph

Claims 1, 2 and 4-12 are currently rejected by the Office under 35 U.S.C. § 112, first paragraph as not being enabled (*id.* at 4-5) for Allium species other than *A. cepa*. *Id.* at 3-4. Applicants respectfully request that this rejection be withdrawn in light of the below remarks.

To the extent the Office maintains its rejection of claims 1, 2 and 4-12 under 35 U.S.C. § 112, first paragraph as not being enabled for Allium species other than *A. cepa* (*id.* at 4-5), Applicants submit for convenience the manuscript referred to above, referred to previously in the March 24, 2005 Amendment, and referred to previously in the declaration by Dr. Colin Eady. Applicants acknowledge that the pending *Plant Cell Reports* article “has not been considered” by the Office (*id.* at 2) thus far, but request that it be done so here in conjunction with the declaration to which it appends. Importantly, the article details the straight forward use of the teachings provided by the present application to transform several species of Allium.

Specifically, as noted in the declaration filed on March 24, 2005, the article demonstrates the successful use of the method set forth in the present application for the transformation of two additional Allium species, leek (*A. porrum*) and garlic (*A. sativum*). Applicants believe this demonstrates that the application provides the manner and process of making and using the invention, in terms sufficient to enable any person skilled in the art of plant transformation. Moreover, the results as detailed in the attached article highlight the premise that an application disclosing even one species encompassed within a genus may be sufficient for the purposes of section 112, first paragraph, to constitute disclosure of the entire genus. *See Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1327 (Fed. Cir. 2002) (granting petition for rehearing and vacating prior panel decision reported at 285 F.3d 1013 (Fed. Cir. 2002)) (citing *In re Smythe*,

480 F.2d 1376, 1383 (CCPA 1973) for proposition that disclosed representative species which “indicate that the patentee has invented species sufficient to constitute the genera, . . . may be representative of the scope of those claims.”). Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

To the extent that the Office bases its current 112, first paragraph, rejection on “Applicant’s arguments filed 09 September 2004,” as mentioned by the Office, the Applicants note that such arguments may be no longer applicable when referred to generically – particularly since the most recent Amendment prior to this one was filed on March 24, 2005. In other words, the Amendment filed by the Applicants on September 9, 2004 responded to the Office’s April 20, 2004 Action, which, in many respects, no longer applies. Since then, Applicants have amended its claims several times. For instance, claims prior to the September Amendment were drawn to all DNA transfer techniques and were subsequently narrowed to *Agrobacterium*-mediated transformation. Moreover, a former rejection requested that time, duration and concentration be provided. Clarifying amendments to the claims were then provided. To the extent the Office wishes to point to specific aspects of previous Actions that it feels still apply, the Applicants are prepared to address them in whatever forum is most convenient for the Office, whether by Amendment, or an in-person interview, or by phone. Currently though, Applicants respectfully request this rejection be withdrawn as improper and overcome with the most recent amendments.

Finally, Applicants acknowledge the Office’s statement that the “Applicants are enabled for the scope of Allium cepa L (onion) . . .” Office Action, at 4. Further, since the claim was “objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

in independent form . . ." Applicants provide new claims 16 and 17. Claims 16 and 17 are drawn specifically to *Allium cepa*, and thus, Applicants obviate this objection.

35 U.S.C. § 102

According to the Office, claim 14 is rejected under 35 U.S.C. § 102(e) as being anticipated by Peffley, et al., U.S. 6,583,335. *Id. at 4*. Claim 14 has been canceled and thus, this rejection is moot.

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 18, 2005

By:


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